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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/020,122	02/06/1998	FREDERIC J KIRKLIN	980106	2906

40158 7590 05/11/2006

WOODS FULLER SHULTZ & SMITH P.C.  
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EXAMINER

PATEL, JAGDISH

ART UNIT PAPER NUMBER

3624

DATE MAILED: 05/11/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 09/020,122	<b>Applicant(s)</b> KIRKLIN ET AL.	
	<b>Examiner</b> JAGDISH PATEL	<b>Art Unit</b> 3624	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 9/24/2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-15, 26-39 and 54 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 54 is/are allowed.
- 6) ☒ Claim(s) 1-15 and 26-39 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

**DETAILED ACTION**

1. This communication is in response to amendment filed 1/4/06.

***Response to Amendment***

2. Claims 13 has been amended. Claims 1-15, 26-39 and 54 are currently pending.

***Response to Arguments***

3. Applicant's arguments with respect to claims have been considered. Whereas the applicant's arguments with regard to claims 1-15, 26-39 are persuasive and thereby rendering the claims allowable based upon the arguments. However, claim 54 stand rejected over Walsh reference. In particular, the applicant argues that Walsh fails to teach the limitation "providing the customer an option to respond, according to the customer's preference, with a requested product identification in spoken words and an option to respond with a requested product identification in DTMF-encoded signals". In consideration of this argument, 102(b) rejection of claim 54 over Walsh has been withdrawn.

***Allowable Subject Matter***

4. Claims 1-15 and 26-39 are allowed.

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***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claim 54 is rejected under 35 U.S.C. 103(a) as being unpatentable over Walsh and further in view of Scherer (US 5748711) (Scherer).

Claim 54. A method of merchandise ordering and order fulfillment, said method comprising:

providing an order processing system comprising a central station interfaced to a telephone communication network so as be accessible to customers by telephone for creation of a merchandise order; (see 1A Host server 110)and

assembling a customer order for fulfillment, including the steps of: requesting from a customer a product identification of a product item and a quantity of the product item to be added to the merchandise order;

(col. 12 L 14-38, command messages, col. 32 L 57-67, order processing element 111, col. 33 L 48- col. 34 L 4, refer to order processing)

receiving a requested product identification and a requested product quantity from a customer;

(col. 12 L 14-38, command messages, col. 32 L 57-67, order processing element 111, col. 33 L 48- col. 34 L 4, refer to order processing)

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confirming the identity and quantity of the product item to be included in the merchandise order;

(col. 35 L 45-53)

and

comparing the requested product quantity of a product item in a merchandise order to a predetermined limit quantity established for said product item and, if the requested quantity exceeds said predetermined limit quantity, reciting the requested product quantity of the product item to the customer and requesting confirmation from the customer of the requested product quantity of the product item.

(col 35 L 40-45, col. 37 L 22-45, refer to steps shown in Fig. 14).

(please also refer to for further details col. 32 L 55+, order processing , transmit data ..host server 110, col. 33 L 48+, product information and product availability..., col. 34 L 35+ DTMF tonal code..).

Walsh fails to teach “providing the customer an option to respond, according to the customer’s preference, with a requested product identification in spoken words and an option to respond with a requested product identification in DTMF-encoded signals”.

Scherer, in the same field of endeavor, however, teaches a method of merchandise ordering and order fulfillment comprising these features (..telephone as the instrument of data entry (either the caller's phone or the called party's phone or one of the parties may speak the information through voice recognition), to be prompted during the call , see col. 1 L 40-56).

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Walsh in view of Scherer to provide the customer the option to respond according to the customer’s preference as stated because this would provide flexibility to the customer to provide the requested information via the customer’s telephone system.

### ***Conclusion***

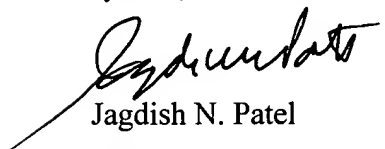
The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to JAGDISH PATEL whose telephone number is (571) 272-6748. The examiner can normally be reached on 800AM-600PM M-Th.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vincent Millin can be reached on (571) 272-6747. The fax phone number for the organization where this application or proceeding is assigned is 517-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Jagdish N. Patel

(Primary Examiner, AU 3624)

5/3/06